

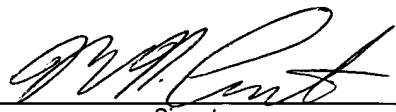
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PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 0905-0266P | |
|---|---|--|--|
| | Application Number 09/922,869-Conf. #8515 | Filed August 7, 2001 | |
| | First Named Inventor Sugio MAKISHIMA et al. | | |
| | Art Unit 2625 | Examiner K. Y. Poon | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>39,491</u></p> <p> _____ Signature</p> <p>_____ Michael R. Cammarata Typed or printed name</p> <p>_____ (703) 205-8000 Telephone number</p> <p>_____ April 20, 2006 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p> | | | |



Docket No.: 0905-0266P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sugio MAKISHIMA et al.

Application No.: 09/922,869

Confirmation No.: 008515

Filed: August 7, 2001

Art Unit: 2624

For: PRINT SYSTEM AND METHOD OF
CONTROLLING OPERATION OF SAME

Examiner: K. Y. Poon

STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Claims 1-6 and 8-13 are pending in this application. Claims 5, 6, 8 and 9 have been withdrawn from consideration.

Claims 1-3, 10 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Parulski and Attenberg, and claims 12 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Wu. Review of the rejections contained in the January 20, 2006, final Office Action is respectfully requested in view of the following remarks.

THE EXAMINER'S RELIANCE ON "COMMON KNOWLEDGE" IS NOT PROPER

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Parulski and Attenberg. The Office Action relies upon "common knowledge" of the following statement to justify combining these references: "...it is well known in the art that things that are united solidly probably are under a same housing." The standards for relying on common knowledge are set out in MPEP 2143.01 and are discussed below. It is respectfully submitted

that no basis for relying on the above statement as “common knowledge” has been provided and that claim 1 is therefore allowable over the art of record.

The Office Action relies on “common knowledge” that things “united solidly are probably under a same housing.” As provided by MPEP 2143.01, “Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection... (emphasis added).” Thus, this reliance on Official Notice in a final Office Action is either improper, or the record should show why this is one of the “rare” cases where official notice is needed.

The MPEP goes on to provide that “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known (emphasis added).” It is submitted that there is no basis for the above assertion in the record or otherwise. It therefore is certainly not capable of instant and unquestionable demonstration. Applicant has traversed this reliance on Official Knowledge and requested that the examiner provide documentary evidence in support of this statement if it was not withdrawn. No such evidence has been provided.

The MPEP also provides that “It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” The principal argument for combining Tamura and Parulski appears to be the above statement, contrary to the requirements of the MPEP.

Furthermore, “if official notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable.” MPEP 2143.01. No technical line of reasoning, much less a clear and unmistakable technical line of reasoning, was provided in the final Office Action. It is submitted that the examiner’s analogy to stereo systems presented in the Advisory Action also does not constitute a technical line of reasoning to support reliance on official notice.

Finally, the MPEP provides that “if Applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must

support the finding with adequate evidence.” Based on the above statements regarding the impropriety of the present reliance on Official Notice, Applicant hereby challenges the factual assertion, quoted above, being relied upon in support of the present rejection. The rejection of claim 1 based on Tamura, Parulski and Attenberg is submitted to be improper, and the withdrawal of this rejection is respectfully requested.

A PROPER MOTIVATION FOR COMBINING THE REFERENCES
HAS NOT BEEN PROVIDED

The rejection of claim 1 is based on a combination of Tamura and Parulski and Attenberg. The Office Action acknowledges that Tamura does not show elements in a housing as claimed. However, Parulski and Attenberg are cited to show that it is possible to place multiple elements of a print system in a kiosk. It is respectfully submitted that a proper motivation for combining these references has not been provided. As provided in the MPEP, the fact that it might be possible to modify a reference does not constitute a basis for an obviousness rejection unless a motivation for making a combination or modification can be shown. MPEP 2143.01. It is therefore respectfully submitted that a proper motivation for combining references has not been shown, that a *prima facie* case of obviousness has not been presented, and that claim 1 is allowable over the references of record.

The Office Action offers several statement that may be intended to show a motivation to combine or modify references. It is respectfully submitted, however, that the Office Action may be confusing a desirable goal with a motivation that would lead a person to that goal. For example, reducing the cost of an existing product is generally considered desirable. This does not mean, however, that every method of reducing cost is obvious. In other words, the fact that a goal is desirable does not indicate that a particular means of attaining that goal is obvious. In the present case, the “motivations” for combining references are submitted to be no more than statement of goals. It is not even clear that these “goals” are recognized in the prior art – some seem to be taken from the present disclosure. Thus, the Office Action states a combination would be obvious “to reduce space such that rent would be reduced for commercial vendors.” There is no basis for this statement in the prior art, and even if true, it does not mean that every modification to a reference that saves space is obvious. It is further stated that “the system

would be well protected.” This may be desirable, but the art of record in no manner suggests inadequate protection is a problem that needs to be addressed. Finally, “let users know it a system as a whole for convenient.” This “goal” may be understood from the present disclosure, but it does not come from the references of record, and no explanation has been provided to show why this statement would be known to those skilled in the art.

The Advisory Action discusses “benefits” that would be obtained by combining the references of record. However, it is respectfully submitted that identifying alleged benefits of a combination in hindsight does not show why one skilled in the art would have been motivated to combine references without the benefit of the present disclosure.

For these reasons, it is respectfully submitted that a motivation for combining Tamura, Parulski and Attenberg has not been provided, that a *prima facie* case of obviousness has not been presented, and that claim 1 is allowable over the references of record.

Claims 2, 3, 10 and 11 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Wu. Tamura is alleged to show all elements required by claim 12 except for a keypad for inputting a contact destination. Wu discloses a digital camera having a keypad 8. It is respectfully submitted that the fact a digital camera might have a keypad in no manner suggests replacing Tamura’s receiver 211 with a keypad. Moreover, the motivation for making this combination is unsupported by the art of record. It is respectfully submitted that even if the modification would have “allowed digital camera with keypad to make use of Tamura’s invention to increase the market share to increase profit,” this is a statement of an alleged result of the combination, not a motivation to make the combination in the first place. As discussed above, “increasing market share” is presumably desired by nearly all merchants; this does not mean that every invention that leads to an increased market share is obvious. A proper motivation for combining references has not been identified, a *prima facie* case of obviousness has not been presented, and claim 12 is submitted to be allowable over the art of record.

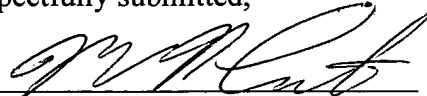
Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Wu. This rejection is respectfully traversed for the reasons provided above in connection with claim 12.

CONCLUSION

For the above reasons, reconsideration and allowance of claims 1-4, and 10-13 is respectfully requested.

Dated: April 20, 2006

Respectfully submitted,

By 

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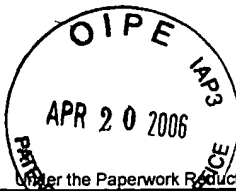
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3 AF
JW

Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

Complete if Known

| | |
|----------------------|------------------------|
| Application Number | 09/922,869-Conf. #8515 |
| Filing Date | August 7, 2001 |
| First Named Inventor | Sugio MAKISHIMA |
| Examiner Name | K. Y. Poon |
| Art Unit | 2625 |
| Attorney Docket No. | 0905-0266P |

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____
☐ Deposit Account Deposit Account Number: 02-2448 Deposit Account Name: Birch, Stewart, Kolasch & Birch, LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
| | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | |
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | |
| Plant | 200 | 100 | 300 | 150 | 160 | 80 | |
| Reissue | 300 | 150 | 500 | 250 | 600 | 300 | |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity Fee (\$) |
|--|----------|-----------------------|
| Each claim over 20 (including Reissues) | 50 | 25 |
| Each independent claim over 3 (including Reissues) | 200 | 100 |
| Multiple dependent claims | 360 | 180 |

| | | | | |
|----------------------|---------------------|-----------------|----------------------|--------------------------------------|
| <u>Total Claims</u> | <u>Extra Claims</u> | <u>Fee (\$)</u> | <u>Fee Paid (\$)</u> | <u>Multiple Dependent Claims</u> |
| _____ | _____ | _____ | _____ | <u>Fee (\$)</u> <u>Fee Paid (\$)</u> |
| _____ | _____ | _____ | _____ | _____ |
| <u>Indep. Claims</u> | <u>Extra Claims</u> | <u>Fee (\$)</u> | <u>Fee Paid (\$)</u> | |
| _____ | _____ | _____ | _____ | |
| _____ | _____ | _____ | _____ | |

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| | | | | |
|--|---------------------|---|-----------------|----------------------|
| <u>Total Sheets</u> | <u>Extra Sheets</u> | <u>Number of each additional 50 or fraction thereof</u> | <u>Fee (\$)</u> | <u>Fee Paid (\$)</u> |
| _____ | _____ | _____ | _____ | _____ |
| _____ - 100 = _____ /50 _____ (round up to a whole number) x _____ = _____ | | | | |

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1401 Notice of appeal 500.00

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|-------------------|----------------------|-----------------------------------|----------------|
| SUBMITTED BY | | | |
| Signature | | Registration No. (Attorney/Agent) | 39,491 |
| Name (Print/Type) | Michael R. Cammarata | Telephone | (703) 205-8000 |
| | | Date | April 20, 2006 |